

U.S. Application No. 09/606,934

Docket No. 0905-0239P

March 17, 2004

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**REMARKS**

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks. Claims 7 and 15-30 are pending. Of these, the Examiner withdrew claims 15-30 from consideration.

**ELECTION/RESTRICTION NOT PROPER**

In the November 17, 2003 Office Action, the Examiner withdrew the Restriction Requirement issued in the Office Action dated July 29, 2003. The Examiner asserted that the claims 15-30 added in the Reply filed on May 12, 2003 are directed to an invention that is independent or distinct from the invention originally claimed. *See November 17, 2003 Office Action, item 2.* Thus, the Examiner withdrew them from consideration and has construed claim 7 as being elected by original presentation.

Applicant respectfully submits that the Examiner has failed meet the standard to properly restrict the claims. Applicant respectfully requests that all pending claims be examined on the merits.

First, in order to properly restrict, the Examiner must demonstrate that the two or more claims are able to support

separate patents and they are either **separate or distinct**. Also, even if the claims are separate or distinct, the Examiner **must** examine the application on the merits if the search and examination can be made **without serious burden**. See *M.P.E.P.* §803.

The Examiner has failed to meet either criteria. First, reasons for holding of independence or distinctness must be provided. See *M.P.E.P.* §816. The Examiner has failed to do so. The purported reasons stated in the November 17, 2003 Office Action is nothing more than a repetition of the elements of the claims. Thus, at best, the assertion of the new claims being independent or distinct is a mere statement of conclusion. However, *M.P.E.P.* clearly states that "A mere statement of conclusion is **inadequate**." *Emphasis added*; See *M.P.E.P.* §816. Indeed, *M.P.E.P.* also states that "The reasons upon which the conclusion is based should be given."

In addition *M.P.E.P.* also states that "The separate inventions should be identified by a grouping of the claims with a short description of the total extent of the invention claimed in each group, specifying the type or relationship of each group as by stating the group is drawn to a process, or to

subcombination, or to product, etc., and should indicate the classification or separate status of each group, as for example, by class and subclass." See *M.P.E.P.* §816.

In the November 17, 2003 Office Action, the Examiner failed to provide the reasons upon which conclusion is based and failed to provide any identification of the groupings with any type of descriptions. Simply stated, the Examiner has failed to meet his burden of establishing that the claims are independent or distinct.

Second, the Examiner also failed to meet his burden of establishing that there would be a serious burden. In this regard, it is noted that the Examiner did not even allege any serious burden whatsoever.

In short, the Examiner has failed to establish that the claims are independent or distinct. Even if the claims are indeed independent or distinct, the Examiner has failed to establish that it would be a serious burden to examine the application in its entirety. Indeed, Applicant respectfully submits that there would be no serious burden. Therefore, Applicant respectfully requests that all pending claims be examined on the merits.

§ 103 REJECTION - ALPEROVICH, NIWA

In the November 17, 2003 Office Action, the Examiner asserts that claim 7 unpatentable over Alperovich et al. (USPN 6,317,609, hereinafter "Alperovich") in view of Niwa (USPN 6,538,692). Applicant respectfully traverses.

For a Section 103 rejection to be proper, a *prima facie* case of obviousness must be established. See *M.P.E.P.* 2142. One requirement to establish *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. See *M.P.E.P.* 2142; *M.P.E.P.* 706.02(j). Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

As to claim 7, the judgment means of the portable telephone set judges whether or not the data amount of the image data to be received by said second receiving means is not more than the amount of data which can be stored in said second image processor. This is performed independent of the portable telephone set. The Examiner admitted that Alperovich may not be relied upon to teach or suggest this element of the claimed

invention. However, contrary to the Examiner's assertion, Niwa also cannot be relied upon as well.

Also, when the judgment means of the portable telephone set judges that the data amount of the image data to be received by the second receiving means is not more than the amount of data which can be stored in the second image processor, the second receiving means receives the image data transmitted through the communication network. Neither Alperovich nor Niwa may be relied upon to teach or suggest this element of the claimed invention.

Further, the Examiner's reliance on Niwa's disclosure is flawed. Niwa discloses an image recording system where information is received from a device, such as a CCD camera. See Niwa, Figure 2. When the data is received from the camera, a determination may be made whether or not the amount of information is larger than the amount of free space left on a storage medium. See Niwa, column 5, lines 63-65 and column 6, lines 6-7.

However, it is important to note that the data received from the CCD camera 2 is **NOT** interrupted at all. The data is simply redirected to an alternative memory (internal or

not  
in  
claim

external). See Niwa, column 5, line 66 - column 6, line 5 and column 6, lines 8-14. This is to achieve the stated objective of Niwa to allow all desired image data to be recorded without interruption.

Thus, the motivation in Niwa behind including a capability to compare information amount from the camera to the available free space is so that alternative memory source may be utilized to record the data. The data is **always** received. This is in **complete contrast** to claim 7 for including the judgment means in which the data ~~is only received~~ if there is enough storage space. In other words, the data is **not** always received. Thus, the Examiner's purported motivation to combine is **not applicable**.

*not in claim*

For at least these reasons, claim 7 is distinguishable from the combination of Alperovich and Niwa. Applicant respectfully requests that the rejection of claim 7, based on Alperovich and Niwa, be withdrawn.

#### CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there

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be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant respectfully petitions for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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